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Applicant(s) **Douglas B. Wilson**
Serial No. **10/727,306**
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Title **FATIGUE RELIEVING SUPPORT FOR STEERING WHEELS AND THE LIKE**
Examiner **Vinh Luong**
Unit **3682**

REPLY BRIEF UNDER 37 C.F.R. §41.41

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SIR:

This is a Reply Brief pursuant to 37 C.R.F. §41.41 in response to the Examiner's Answer dated January 25, 2008.

I. General

This paper is in reply to the Examiner's Answer dated January 25, 2008. In that Answer, the Examiner stated his basis to support his indefiniteness, anticipation, and obviousness-type double patenting rejections of the claims on appeal, claims 14-19, 24/14, and 27. Claims 14-19, 24/14, and 27 were rejected for indefiniteness under 35 U.S.C. §112, second; claims 14-17, 19/17, 24/14, and 27 were rejected for anticipation under 35 U.S.C. §102 in light of U.S. Patent No. 2,118,540 to Van Arsdel ("Van Arsdel") or U.S. Patent No. 2,134,020 to Anson ("Anson"); and claims 14, 18, and 19/18 were rejected for anticipation under 35 U.S.C. §102 in light of U.S. Patent No. 1,575,848 to Laubach ("Laubach"). Finally, the Examiner has provisionally rejected claims 14-19, 24/14, and 27 under the judicially-created doctrine of obviousness-type double patenting over claims 20-28 of co-pending parent application U.S. Patent Application Ser. No. 10/720,821, filed November 24, 2003 also on appeal. The obviousness-type double patent rejection is not being appealed. However, if the Board reverses the Examiner in

this Appeal and the Appeal with regard to U.S. Patent Application Ser. No. 10/720,821, Appellant will file a terminal disclaimer to overcome any obviousness-type double patenting rejection.

The legal and factual bases relied on by the Examiner in the Examiner's Answer as support for his indefiniteness and anticipation rejections are misplaced. More specifically, the case law cited by the Examiner to support the indefiniteness rejection actually supports Appellant making it appropriate to cite the dictionary definitions filed by Appellant during prosecution on the merits of record to show what the ordinary meaning of the terms rigid, semi-rigid, flexible, and non-deformable would be. Further, the factual explanations the Examiner advances in the Examiner's Answer to make out the *prima facie* bases for anticipation actually support Appellant's position that claims 14-19, 24/14, and 27 are patentable over Van Arsdel, Anson, and Laubach.

II. The *Phillips* Case Supports Appellant

In the Examiner's Answer, the Examiner relied primarily on *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) to support his position that the dictionary definitions that have been made of record by Appellant to show the ordinary meaning of common terms in the English language should have no weight. Appellant submits that *Phillips* supports Appellant for them to be considered.

In support of the indefiniteness rejection, the Examiner stated the following with regard to Appellant providing dictionary definitions of common English language words to show their meaning:

In the instant case Appellant relied on extrinsic evidence, such as, *Ninth New Collegiate Dictionary*. The Examiner respectfully submits that the specification is the single best guide to the meaning of a claim term. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 [75 USPQ2d 1321](Fed. Cir. 2005)(en banc). See also, e.g., the meaning of the term "adjustable" in *Curtiss-Wright Flow Control Corp. v. Velan Inc.*, 77 USPQ2d 1988 (Fed. Cir. 2006). Since Appellant's specification does not provide guidance as to, *inter alia*, (a) what type of material(s) is (are) considered to be "rigid, semi-rigid, or flexible, or non-deformable," and (b) what objective test(s) is (are) required in order to determine whether a material is "rigid, semi-rigid, or flexible, or nondeformable." Thus, Appellant's claims are unclear and/or ambiguous. [Emphasis in original.]

Examiner's Answer, pp. 9-10.

First, Appellant would like to point out that the Examiner's description of the indefiniteness rejection has changed over time from what was stated in the Office Action dated March 30, 2006, the first time the claims were finally rejected for indefiniteness, but throughout this time, Appellant has not changed the claims. In the March 30th Office Action, the Examiner stated (Attachment A hereto for convenience):¹

The term "rigid," "semi-rigid," "flexible," or "non-deformable" in claims 14 and 27 is a relative term, which renders the claims indefinite. The term "rigid," "semi-rigid," "flexible," or "non-deformable" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. For example, it is unclear what range of Rockwell hardness of the material of the second section is required in order to be considered as being "rigid," "semi-rigid," "flexible," or "non-deformable." [Citation omitted.]
Office Action dated March 30, 2006, p. 3.

The Examiner sought to rely on his indefiniteness position taken in the March 30th Office Action in the "Advisory Action Before the Filing of an Appeal Brief" dated July 14, 2006 ("Advisory Action") (Attachment B hereto for convenience).² In the Advisory Action, the Examiner stated:

Continuation of 11. See the reasons set forth in the [first] Final Office [A]ction on March 30, 2006. In addition, with respect to:

(a) Applicant's reliance on extrinsic evidence, such as, Webster's Dictionary, the Examiner respectfully submits that the specification is the single best guide to the meaning of a claim term. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 [75 USPQ2d 1321](Fed. Cir. 2005) (en banc). Moreover, Applicant's arguments are similar to the arguments presented in co-pending Application No. 10720821, the Examiner's Response in the final rejection on May 9, 2006 of Appl. '821 is incorporated here by reference.

Advisory Action, p. 2.

¹ The March 30, 2006 Office Action is Attachment A to the Evidence Appendix to the Appeal Brief.

² The Advisory Action is Attachment D to the Evidence Appendix to the Appeal Brief.

In the first Examiner's Answer dated September 13, 2006 (Attachment C hereto for convenience), the Examiner relied on the following to support his indefiniteness rejection:³

Regarding Appellant's reliance on extrinsic evidence, such as, *Ninth New Collegiate Dictionary*..., the Examiner respectfully submits that the specification is the single best guide to the meaning of a claim term. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 [75 USPQ2d 1321](Fed. Cir. 2005)(en banc). See also, e.g., the meaning of the term "adjustable" in *Curtiss-Wright Flow Control Corp. v. Velan Inc.*, 77 USPQ2d 1988 (Fed. Cir. 2006). Since Appellant's specification does not provide guidance as to what type of material(s) is (are) considered to be "rigid, semi-rigid, or flexible, or non-deformable." Thus, Appellant's claims are *unclear and/or ambiguous*. [Emphasis in original.]

[First] Examiner's Answer, p. 5.

Next, the Examiner changed his position again in the (second) Examiner's Answer dated January 25, 2008, where as indicated above at Page 2, there is now the requirement for Appellant to name in the specification an "objective test" for interpreting the plain and ordinary meaning of commonly used terms. Appellant's position is this is improper. Such a requirement by the Examiner is not supported given that Appellant has clearly shown that one of ordinary skill in the art would understand the meaning of the terms at issue as confirmed by the dictionary definitions made of record.

Appellant submits that the two Examiner's Answers dated September 13, 2006 and January 16, 2008, respectively, do not support the Examiner's position. However, Appellant will address the Examiner's position in the Examiner's Answer dated January 16, 2008, since it is the last position in time taken by the Examiner.

As stated, the Examiner has relied principally on *Phillips* to support Appellant's inclusion of the definitions from *Webster's Ninth Edition* should not have any weight in description of the terms "rigid," "semi-rigid," "flexible," or "non-deformable." Appellant, however, asserts that a reading of *Phillips* does support Appellant's position that these dictionary definitions are appropriate to show what these commonly used terms mean. The Examiner does not recognize *Phillips* in this regard. In the pertinent part, *Phillips* states:

³ The (first) Examiner's Answer dated September 13, 2006 is attached hereto as Attachment C, and is requested to be added to the Evidence Appendix as Attachment H.

In some cases, the ordinary meaning of claim language as understood by a person of skill in the art may be readily apparent even to lay judges, and claim construction in such cases involves little more than the application of the widely accepted meaning of commonly understood words. See *Brown v. 3M*, 265 F.3d 1349, 1352 (Fed. Cir. 2001) (holding that the claims did “not require elaborate interpretation”). In such circumstances, general purpose dictionaries may be helpful.

Phillips v. AWH Corp., 415 F.3d at 1314.

Appellant asserts that the terms “rigid,” “semi-rigid,” “flexible,” and “non-deformable” are common terms as would be understood by a person of ordinary skill in the art in the context of the application on appeal and these terms have no special meaning beyond that. As such, it is appropriate to provide the meanings from Webster’s to be instructive of their common meanings.

The Examiner’s new statement that “objective tests” must be provided is not supported in *Phillips*, where, as here, the meaning of the terms objected to by the Examiner have a plain and ordinary meaning as evidenced by dictionary definitions provided. This new requirement is an attempt to more generally restate the alleged need for “Rockwell-type tests” the Examiner raised and retracted after it was challenged by Appellant. This retraction is evidenced by the Examiner’s change of position from the (first) final rejection dated March 30, 2006 to the (first) Examiner’s Answer dated September 13, 2006.

Appellant submits that he has demonstrated through the dictionary definitions that each of the terms at issue has a plain and ordinary meaning and no special meaning. Thus, it is appropriate to refer to dictionary definitions to confirm that, as Appellant did, as taught by *Phillips*.

Appellant respectfully requests that the Board reverse and remand the indefiniteness rejection and in remanding instruct the Examiner to reverse and withdraw this rejection.

III. *In re Schreiber Does Not Support the Examiner’s Position*

In the related appeal for Application Ser. No. 10/720,821 filed November 24, 2003, the Examiner contended that *In re Schreiber*, 128 F.3d 1473, 1477-48, 44, USPQ2d 1429, 1431-32 (Fed. Cir. 1997) supported his anticipation rejections. Specifically, *Schreiber* was relied on with respect to each of the anticipation rejections based on Van

Arsdel, Anson, and Laubach. In the Examiner's Answer in the present appeal, however, the Examiner only cited *Schreiber* with regard to the anticipation rejection based on Laubach and tangentially with respect to Van Arsdel. Since the claims of the present application were similar enough to those of the related appeal for the Examiner to raise an obviousness-type double patenting rejection against the claims of the present appeal, Appellant believes it's appropriate to address *Schreiber* as if the Examiner had raised this case to support the anticipation rejections based on Van Arsdel, Anson, or Laubach.

In the Examiner's Answer in the present appeal, the Examiner stated the following with regard to anticipation rejection based on Laubach:

Appellant contended that the knobs of Laubach are rigidly connected to the steering wheel by the screws 5, thus, the knobs are meant to remain in place in operation. Nevertheless, common sense teaches that the driver can unscrew Laubach's screws 5, and then screw or fasten the screws 5 at other positions on the rim 6 of the steering wheel as the driver so desires. In other words, the position of Laubach's knobs is capable of being changed. As such, Laubach's knobs can inherently perform the functions recited in Appellant's claim. *In re Schreiber*, 128 F.3d 1437[sic], 44 USPQ2d 1429 (Fed. Cir. 1997).

Appellant further asserted that the knob of Laubach does not deform out of interference with the operation of the steering wheel as set forth in claim 14. The Examiner respectfully submits that the driver can unscrew Laubach's screws 5, and then screw or fasten the screws 5 at other position[s] on the rim 6 of the steering wheel such that the new position is out of interference with the operation of the steering wheel as the driver desires. The operation to adjust or change the position of Laubach's handgrips is similar to the operation to adjust the handgrips of Arsdel since both Laubach and Arsdel use screws as fastening means. Since the position of Laubach's knobs is capable of being changed to be out of interference with the operation of the steering wheel, therefore, Appellant's claims are anticipated by Laubach. *In re Schreiber; Ex parte Masham*; and MPEP 2114, *supra*.

Examiner's Answer, p. 14.

In the above quotation, the Examiner seeks to equate unscrewing a fixed handgrip, drilling a new screw hole at a new location along the rim, and then reattaching the handgrip at the new location to the deforming of the second section as recited in the claims on appeal. Appellant avers that this is not supported by the evidence or *Schreiber*.

Appellant submits the facts of *Schreiber* are inapposite to the present application. In *Schreiber*, the portion of the claimed invention at issue and the prior art had the same

shape and the applicant there sought to distinguish the claimed invention from the prior art by stating that the prior art did not perform in the same manner as the claimed invention. To this end, Schreiber (inventor) submitted a declaration stating the same. In this regard, *Schreiber* states:

There is no dispute that the structural limitations recited in Schreiber's application are all found in the Harz [prior art] reference upon which the examiner and the Board relied. Thus, to use the terms found in Schreiber's claim 1, Harz discloses a "dispensing top" that has "a generally conical shape and an opening at each end," and "means at the enlarged end of the top to embrace the open end of the container, the taper of the top being uniform." Schreiber argues, however, that Harz does not disclose that such a structure can be used to dispense popcorn from an open-ended popcorn container [rather than oil]. [Emphasis added.]

In re Schreiber, 128 F.3d at 1477.

The Federal Circuit in response to this argument by Schreiber stated:

Although Schreiber is correct that Harz does not address the use of the disclosed structure to dispense popcorn, the absence of a disclosure relating to function does not defeat the Board's finding of anticipation. It is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable [Citations omitted]. Accordingly, Schreiber's contention that his structure will be used to dispense popcorn does not have any patentable weight if the structure is already known, regardless of whether it has ever been used in any way in connection with popcorn.

In re Schreiber, 128 F.3d at 1477.

Appellant submits that the Examiner is relying on the quotation immediately above to support his rejection; this is improper. In *Schreiber*, a comparison of the prior art and the claimed invention showed that they looked the same and the inventor Schreiber was arguing despite the prior art structure, such prior art would not *function* the same as the claimed invention. Appellant is not making such a contention. What Appellant is asserting and the Examiner fails to recognize is that the claims of the present application positively recite structural and functional features that combined distinguish these claims from the prior art. *Schreiber* addresses this but the Examiner fails to appreciate the Federal Circuit's position on this issue.

On page 1478, *Schreiber* specifically addresses patentability where functional and structural features are involved but at a location not cited by the Examiner. This is believed because the Examiner only appears to cite to the bridging language at pages

1477 and 1478. The portion of *Schreiber* on page 1478 germane to the question at issue in the present appeal is where the Federal Circuit raises the issue of functional features being a basis for patentability. At this later location on page 1478, it states:

Schreiber further argues that the functional limitations of his claim distinguish it from Harz. In particular, Schreiber points to the recitation that the claimed top "allows several kernels of popped popcorn to pass through at the same time," and that the taper of the top is such "as to by itself jam up the popped popcorn before the end of the cone and permit the dispensing of only a few kernels at a shake of a package when the top is mounted on the container."

In re Schreiber, 128 F.3d at 1478.

What the Examiner fails to appreciate in *Schreiber* is the Federal Circuit's explicit treatment of functional limitations for providing a basis for patentability. In this regard, the Federal Circuit states:

A patent applicant is free to recite features of an apparatus either structurally or functionally. See *In re Swinehart*, 58 C.C.P.A. 1027, 439 F.2D 210, 212, 169 USPQ 226, 228 (CCPA 1971) ("[T]here is nothing intrinsically wrong with [defining something by what it does rather than what it is] in drafting patent claims."). Yet, choosing to define an element functionally, i.e., by what it does, carries with it a risk. As our predecessor court stated in *Swinehart*, 439 F.2d at 213, 169 USPQ at 28:

where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. [Citations omitted.]

In re Schreiber, 128 F.3d at 1478.

The Examiner's citation to *Schreiber* is not directed to the Federal Circuit's pronouncement that patentability may be established through functional limitations when he stated that "claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than functions"[emphasis added] and cites *Schreiber* as support. As shown above, *Schreiber* does not state this and, in fact, it states the contrary. Thus, the Examiner has advanced an incorrect interpretation of the case.

When the functional limitations of claims 14-19, 24/14, and 27 were raised as at least one basis for patentability and it was challenged by the Examiner, it became Appellant's burden to show that the functional limitations were not inherent features of

the prior art being relied. *See In re Schreiber*, 128 F.3d at 1478. In response to this challenge, Appellant provided clear evidence to show that the apparatus of Van Arsdel, Anson or Laubach did not have a second section that deformed according to the claims on appeal. Appellant has met his burden with respect to each of the references relied on by the Examiner. Appellant, therefore, has shown why the functional limitations were not inherent features in any of the three references. This will now be discussed in detail.

1. Van Arsdel Does Not Anticipate Claims 14-17, 19/17, 24/14, and 27

In the Appeal Brief, Appellant pointed out to the Examiner that Van Arsdel differed in at least the following way in discussing the Examiner's alleged position that Van Arsdel anticipates the present invention:

The rotation of the steering wheel by hand pressure against the flanges 4 and 5 is assisted by the palm and fingers which are wrapped around the rim of the wheel, and to increase the finger hold of the grip-rest, 2, which is thickened and bifurcated to straddle the rim as shown in Fig. 6, is provided with recesses separated by ridges here shown as three in number, 6, 7, and 8....

The weight of the hand and arm are comfortably supported with the bottom of the hand resting in the concavity of the grip-rest as shown in Fig. 1, or with the ball of the thumb seated in the concavity as shown in Fig. 2....

My improved grip-rest may be formed integrally with the rim of the steering wheel as shown in Fig. 8, but I prefer to make it removable as an attachment for any make of car and also to make it adjustable to suit the requirements or fancy of the driver.

Van Arsdel, Page 1, Right Column, Lines 29-54.

* * *

The Examiner contends that the grip-rest is deformable. However, Appellant submits this is not supported by Van Arsdel. Van Arsdel requires the following to move the grip-rest: loosen the screw, reposition the grip-rest, and retighten the screw. (Van Arsdel, Page 2, Left Column, Lines 28-32) Appellant submits that this is not deforming according to claim 14 during normal use of the grip-rest because once the grip-rest of Van Arsdel is in place, it is fixed, and does not move. Thus, Van Arsdel is missing at least the deforming element.

Appellant's position on the teachings of Van Arsdel is supported by the reference:

The grip-rest 2 is concave longitudinally and about half of the rest extends over and part way across a steering wheel rim 3 in a manner to slope downwardly and inwardly of the rim. The outer edge 4 of the side, and 5 of the rear end of the concave, located above the rim, extends up into a marginal flange to be contacted by the inside of the ball of the thumb or by the bottom of the hand, depending upon which part of the hand is seated on the rest. These flanges 4 and 5 enable the operator instantly to feel any deviation of the car from a straight course and give him something substantial to push against in resistance and also in rotating the wheel to steer the car around corners and curves and away from obstructions or bad places in the roadway. [Emphasis added]

Van Arsdel, Page 1, Right Column, Lines 13-28.

The quotation immediately above clearly demonstrates that the grip-rest of Van Arsdel does not deform according to claim 14 when pressure is applied to it. Noting this, Van Arsdel is missing at least one element, therefore, it cannot establish a *prima facie* basis of anticipation. Appeal Brief, pp. 9-11.

Appellant's position above and a review of Van Arsdel make plain, there is a basis for the Board to reverse and remand the anticipation rejection based on Van Arsdel with instructions for the Examiner to withdraw this rejection.

2. Anson Does Not Anticipate Claims 14-17, 19/17, 24/14, and 27

In the Appeal Brief, Appellant distinguished Anson and noted the Examiner put tremendous weight on the description of the Attachment (handgrip) in Anson in considering the issue of anticipation. In the Appeal Brief, Appellant stated the following:

I [Anson] have found that in the driving of an automobile and particularly when driving for extended periods of time over long distances, the normal manner of holding and manipulating the steering wheel, wherein both driver's hands grasp the wheel and positions which require the driver's arms to remain in a raised and more or less unnatural and uncomfortable position, considerable strain develops in the driver's hands, arms, shoulders and back particularly, and results in excess of fatigue...

To obviate these disadvantages, I have devised an attachment for steering wheel, which permits a driver to assume a completely comfortable and relaxed driving position, while at the same time, affords a means permitting the driver to at all times retain positive operating control of the steering wheel. [Emphasis added.]

Anson, Page 1, Left Column, Lines 6-25.

The steering wheel attachment of Anson is described as follows:

The attachment comprises a hand grip portion 11, which is preferably of bulbular form.... Grip portion 11 normally extends downwardly from the wheel rim and is of suitable length to adapt same to extend to the region of the driver's lap so that it may be grasped by the driver's hand when his hand is resting in a normal comfortable position in his lap. Grip portion 11 is reduced in cross-sectional area at one end to form a neck 12. Neck 12...will have sufficient pliability...to be deflected from its normal pendant position without adversely affecting the measure of control of the steering wheel movements afforded by the positive operating movement of the attachment, while at the same time, neck 12 will retain sufficient rigidity to permit operating movements of hand grip 11 to be positively communicated to the steering wheel rim for effective control of its movements. [Emphasis added.]

Anson, Page 1, Right Column, Line 49 – Page 2, Left Column, Line 18.

* * *

The Examiner has cited Anson at Page 2, Left Column, Lines 62-72, as teaching the deformability element of the second section in claim 14. As the quotation above demonstrates, when the Anson handgrip is in use, it is in the pendant position below the steering wheel and used to steer the vehicle. If, during normal operations, the driver were to grab the steering wheel in an emergency situation, he would release the handgrip and grab the wheel, for example, at the 10 and 2 o'clock positions. In doing so, the pendant-hanging handgrip would not be deformed as set forth in the claims on appeal because it would not be in use at all. Moreover, if it were used, it would not be deformed out of interference but would be held in the pendant position to steer the vehicle and not released. Further, if the handgrip is moved to the top of the steering wheel, it would be awkward and dangerous to use because the driver's hands would be disposed through the steering wheel. In this position, it also would not provide any of the benefits recited in Anson to relieve fatigue in the arms and hands of the driver.

Appeal Brief, pp. 12-13.

Like the handgrip of Van Arsdel, the Examiner has equated the act of detaching the Attachment (handgrip) of Arson and moving it to a new location as equivalent to the functional limitations of the claims on appeal. However, it is plain that the Attachment (handgrip) of Anson does not inherently possess the functional limitations of the claims as set forth with respect to the second section. Noting this, Anson is missing at least the deforming element of the claims on appeal and, as such, it does not support a *prima facie*

basis of anticipation. As such, there is a basis for the Board to reverse and remand the anticipation rejection based on Anson with instructions for the Examiner to withdraw the rejection.

3. Laubach Does Not Anticipate Claims 14, 18, and 19/18

In the Appeal Brief, Appellant demonstrated that the invention of claims 14, 18, and 19/18 are distinguishable from Laubach at least because of the functional limitations of the second section of the claimed system. In this Appeal Brief Appellant stated the following:

Laubach states the following with regard to the knobs attached to the steering wheel:

By particularly considering the Figures 2 and 3, it will be seen that these knobs 2 are secured to the rim of the wheel 1 by means of securing screws 4, these screws being threaded as indicated at 5 longitudinally through the knob 2, and extending for quite a distance through the entire length of the knobs, thereby efficiently bracing the same. The inner ends of the knobs 2 are concave as indicated at 6, so as to conform to the contour of the outer periphery of the wheel 1...

Each knob 2 is provided with a plurality of finger sockets 9 upon the upper face thereof, and an enlarged head portion 10 at the outer end thereof, for the purpose of facilitating the gripping of the knob and preventing the accidentally slipping of the hand of the operator from the knob 2. [Emphasis added.]

Laubach, Page 1, Lines 43–71.

The description of the knobs and a review of the Figures make plain that the knobs are not deformable and they are not disposed at an angle with respect to the plane across the face of the steering wheel. The knobs are rigidly connected to the steering wheel by screws 5. Any movement of them requires removing the screws, drilling the wheel at a new location, and reattaching the knobs at the new location. At this new location, the knobs will be in a plane parallel to the plane across the face of the steering wheel.

The knobs do not deform out of interference with the operation of the steering wheel, as does the second section of claim 14. In fact, once the Laubach knobs are secured by screws 5 as shown and described, they are fixed and not movable during normal operations. If they are not unscrewed, the only movement would be to apply a destructive force to the knobs, thereby breaking them. Therefore, Laubach does not support a *prima facie* basis of anticipation because it is missing at least one element

of the claims on appeal relating to deformation of the knobs out of interference with the operation of the steering wheel in the normal operation of the knobs.

Appeal Brief, p. 15.

Appellant has demonstrated that Laubach does not anticipate the claims at issue in this Appeal. As such, Appellant has provided at least one basis for the Board to reverse and remand the anticipation rejection based on Laubach with instructions for the Examiner to withdraw the rejection.

A. *Ex parte Masham* is Misapplied

The Examiner only cited to *Ex parte Masham* in discussing Laubach in the Examiner's Answer. However, in the related appeal, the Examiner stated the following in more detail with respect to *Masham*:

In addition, a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art teaches all of the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. Inter. (1987) Cited in MPEP 2114, *supra*. [Emphasis added.]

Related Examiner's Answer, p. 3.

Given the relationship of the claims of the present application on appeal and related application on appeal (U.S. Patent Application Ser. No. 10/720,821), Appellant believes it is appropriate to address *Masham* as if it was cited in the same manner in the present application on appeal as it was in the related application on appeal.

The facts of *Masham* are that the claimed and prior art device were the same except that the apparatus of the claimed invention was fully submerged for mixing the developer material while the prior art apparatus was only partially submerged. This is not the issue in the application in this appeal.

The claims on appeal are distinguished from Van Arsdel, Anson, and Laubach based on the apparatus of each of these references not having a structure capable of performing the functional limitations of the appealed claims. Moreover, the way that the Examiner has contorted the references to try to show that each performs the functional limitations of the appealed claims is not supported by the respective specifications and improper. The Examiner in each case states that the grip-rest, handgrip, or knob may be removed from a fixed location on the steering wheel rim, moved to another location

along the rim, and then reattached to the rim. Appellant submits that such actions do not anticipate the appealed claims with regard to the second section deforming. Thus, the Examiner's reliance on *Masham* is inappropriate given the inapposite facts of the present case. As such, *Masham* has been misapplied and should not be given weight in the present Appeal.

IV. Van Arsdel and Anson Do Not Anticipate

Although Appellant has addressed the applicability of *In re Schreiber* for supporting the anticipation rejections based on Van Arsdel, Anson, or Laubach, the Examiner has stated separate bases for rejecting claims 14-17, 19/17, 24/14 and 27 for anticipation under 35 U.S.C. §102 based on Van Arsdel and Anson. Each of these bases will now be addressed.

A. Van Arsdel Does Not Anticipate

In rejecting claims 14-17, 19/17, 24/14 and 27 for anticipation based on Van Arsdel, the Examiner stated the following in the Examiner's Answer:

At the outset, Appellant's arguments are not based on limitations appearing in the claims. [Citation omitted.] In fact, Appellant's claim 14 recites "*a rigid, semi-rigid or flexible, or non-deformable second section* that connects to, and extends from the first section outward at an angle to a plane across the front face of the steering wheel." It is clear from claim 14 that it requires the second section of the handgrip, *not* the handgrip *per se*, [to] ... extend from the first section outward at an angle to a plane across the front face to the steering wheel. Therefore, Appellant's contention that the grip rest of Van Arsdel is in a plane parallel with the one across the face of the steering wheel on page 8 of the brief is immaterial to the patentability of the claim. The issue is not whether Arsdel's grip rest is disposed at an angle relative to the plane across the face of the steering wheel. Rather, the issue is whether Arsdel teaches the second section that connects to and extends from the first section outward at an angle relative to the plane across the face the steering wheel. [Emphasis in original.]

Examiner's Answer, p 10.

The quotation immediately above makes plain that the Examiner does not understand the disposition of the element 2 of the Van Arsdel grip-rest or the claims on appeal. First, the invention of the claims on appeal is not a handgrip. Second, the

Examiner in Attachment 1 to the January 25, 2008 Office Action⁴ attempts to show that element 2 is disposed at an angle α to a plane across the face of the steering wheel shown in Figure 3 of Van Arsdel. This is simply not the case.

The disposition of element 2 of the handgrip is shown in Figure 6 in the same plane as a plane across the face of the steering wheel. (Van Arsdel, Page 2, lines 15-27.) Another view of the same handgrip is in Figure 3. As such, Figure 3 does not, as the Examiner contends, show element 2 extending for the steering wheel at an angle α to a plane across the face of the steering wheel. Therefore, the redrawing of Figure 3 as the Examiner has done does not support the proposition he is advancing.

The description of the Figures supports Appellant's contention that redrawing of Figure 3 by the Examiner is error. The description of Figures 2, 3, 4, 5, and 6 makes this clear:

Figure 2 is a like view of the wheel with my invention and with the thumb and fingers of operator in proper driving position.

Figure 3 is a perspective view of the upper side of the wheel and my invention in the operative position with the operator's hand removed.

Figure 4 is a perspective view of the under side of the same wheel shown in Figure 3.

Figure 5 is a fragment of a wheel rim in top plan view with my invention attached.

Figure 6 is a section on the line 6-6 of Figure 5.
Van Arsdel, p. 1, Left column, lines 43-53.

Appellant also submits even if element 2 was disposed as the Examiner contends, it would not anticipate the invention of claims on appeal. When element 2 is fixed on the steering wheel as described in Van Arsdel at page 2, lines 15-27, it is fixed in place and there is no teaching or suggestion in Van Arsdel that it would deform out of interference with the use of the steering wheel, as claimed in the claims on appeal. Therefore, this is a second basis that supports Van Arsdel does not anticipate the claims on appeal.

The Examiner has attempted in the Examiner's Answer to show that even though the hand grip is fixed to the steering wheel, it is deformable out of interference with the

⁴ See Examiner's Answer dated January 25, 2008.

operation of the steering wheel when pressure is placed on it. This is not the case. The Examiner stated the following in the Examiner's Answer:

In the case at hand, on page 1, right column, lines 13-28, Arsdel describes: “[t]he grip rest 2 is *concave* longitudinally and about half of the rest extends over and part way across the steering wheel rim 3 in a manner to slope downwardly and inwardly of the rim. The outer edge 4 of the side, and 5 of the rear end of the *concave*, located above the rim, *extends up into a marginal flange* to be contacted by the inside of the ball of the thumb or by the bottom of the hand, depending upon which part of the hand is seated to rest.” See also Arsdel’s claims 1 and 2. Arsdel’s concave upward section 2 extends from the first section 4 outward at an angle α to a plane across the face of the steering wheel as shown in Figs. 3 and 8 of Attachment 1 of the final action. Therefore, Arsdel’s concave upward section 2 in Fig. 3 of Arsdel “reads on” Appellant’s claimed second section.

In addition, Appellant’s contention that “[o]nce the grip rest if Arsdel’s hand grip is in place, it is fixed, and does not move” is unsupported by substantial evidence in the record. Indeed, on page 1, right column, line 49 through line 2, left column, page 2, Arsdel expressly describes:

My improved grip-rest may be formed integrally with the rim of the steering wheel as shown in Fig. 8, but I prefer to make it removable as an attachment for any make of car and also make it adjustable to suit the requirements or fancy of the driver.
(Emphasis added.)

Particularly, Appellant’s contention is in direct conflict with Arsdel’s description on page 2, left column 2, left column, lines 28-32:

The grip rest *may be shifted* along the length of the rim, or vertically around it by reversing the screw sufficiently to permit *change of the rest to the new position*, where it will be held again by tightening up on the screw. (Emphasis added).

Simply put, Arsdel explicitly teaches that the driver may loosen the screw 14 in Fig. 6 so that it is *deformable* in order that the driver can put extensive pressure on it and *it will move* for steering the automobile.

The support in the description of Arsdel for the statement that the second section will deform out of interference with the operation of the steering wheel is found on page 2, left column, lines 28-32. By loosening or reversing the screw 14 sufficiently to permit Arsdel’s second section 2 shifting vertically around the rim 3, the second section can be at the new position wherein the second section does not interfere with the operation

of the steering wheel to suit the requirements or fancy of the driver.
(Emphasis added and in original.)
Examiner's Answer, pp. 10-12.

A review of the Examiner's quotation above, finds that the Examiner equates a loosely connected grip-rest according to Van Arsdel as anticipating the present invention. Appellant submits this is misplaced.

The loosened grip-rest of Van Arsdel is not described as supporting the hands but merely for repositioning. The repositioning would not be deformation of the grip-rest. The deformation of the second section is clearly shown and described in the claims on appeal and this is fully supported by the specification and at Figures 3 and 4. The grip-rest of Van Arsdel only provides support once it is fixed in place by tightening the screw 14.

The underlined portion of the quotation above is the Examiner's contention that is not supported by the specification. There is no disclosure in Van Arsdel that states that the screw is loosened and extensive pressure is then put on the grip-rest and it will move for steering the automobile. The only description that describes putting extensive pressure on the grip-rest for steering the automobile is when the screw is tightened and it is fixed as shown in Figure 6. Van Arsdel, in the pertinent part states:

In making at assembly the band 9 is wrapped around the wheel rim and the free end of the band is laid across the nut and bent past the ears 12 and 13 with one of the holes 11 in register with the hole at the nut, the ears 12 and 13 are then bent toward each other to clamp and hold the assembly. Then the grip rest is placed as shown in Fig. 6, with its bifurcation receiving the nut and adjacent fasteners of the band and rim, and the threaded end of the screw bolt 14 is screwed into the nut 10 until the grip rest is immovably tightened upon the rim of the wheel.

The grip-rest may be shifted along the length...by reversing the screw sufficiently to permit change of the rest to the new position, where it will be held again by tightening on the screw. [Emphasis added.]
Van Arsdel, p. 2, left Column, lines, 15-32.

The clear teaching of Van Arsdel is that the handgrip is "immovably" tightened to the steering wheel. It is not disposed as the Examiner contends. The loosening of the screw of the Van Arsdel hand grip is for moving it to a new location. There is also no teaching that the Van Arsdel grip-rest is even operable in the intermediate state of the

loosened screw for supporting a hand and deforming as set forth in the appealed claims and the Examiner has not presented evidence that it would be operable at this intermediate state.⁵

Noting the foregoing, Appellant has shown that the Examiner's reliance on an unsupported attempted reconstruction and operation of Van Arsdel is improper. Therefore, the Board should reverse the Examiner's rejection based on Van Arsdel and remand it to the Examiner with instructions to withdraw the anticipation rejection based on Van Arsdel.

V. Anson Does Not Anticipate theAppealed Claims

In the Examiner's Answer, the Examiner contends that because the Anson hand grip is made from pliable material it deformable as set forth in the appealed claims.

Appellant submits a review of Anson does not support the Examiner's contentions.

The Examiner's Answer states the following with regard to Anson in an attempt to support the anticipation rejection based on this reference:

In fact, Anson's grip is made of flexible or semi-rigid material, therefore, Anson's grip is deformable or deflectable out of interference with the vehicular operator's ability to operate the steering wheel, i.e., out of the normal position. See page 2, right column, and lines 25-40 quoted below:

In the modification illustrated in Figs. 4 and 6, neck 12 is constructed of a rubber composition having the same desired characteristics of pliability and semi-rigidity described in connection with the form illustrated in Figs. 1 and 2 and described above. The hand grip portion 11, however, may be made of solid material such as metal, and is detachably connected to neck 12. While the modification does not possess the degree of hand gripping comfort inherent in the principal modification,

⁵ Once the grip-rest is fixed in place, it does not deform out of interference. If it did so, it would not be operating according to the description of that invention. The grip-rest of Van Arsdel is designed to place pressure on it and it will not move. It is only intended to move when it is unscrewed. Appellant has not claimed and is not attempting to claim a system is fixed at one location of a steering wheel and it may be moved by removing a screw to loosen it, and then refixing it at a new location by retightening the screw. The appealed claims are described to a system that has a second section that extends outward from a first section such that the second section extends outward at an angle to a plane across the front face to the steering wheel. This second section also is deformable such that it will deform out of interference with operation of the steering wheel when deforming pressure is applied as is best shown in Figure 3 of the present application. Appellant submits that Van Arsdel does not teach or suggest these features of the appealed claims and, therefore, does not anticipate such appealed claims.

nevertheless, by virtue of the pliability and semi-rigidity of the neck portion; this type of attachment will also provide the advantages of *ready deflection from the normal position* while affording positive control of the wheel movements. (Emphasis added.)

An examiner's answer, p. 12.

As best can be understood from the examiner's comments and citation to the quotation immediately above is that the examiner is attempting to raise some type of inherency argument to contend Anson anticipates the appealed claims. This is not supported by Anson.

Anson in the first paragraph states the purpose and use of the hand grip:

This invention [of Anson] relates to steering wheel attachments and particularly to an attachment for automobile steering wheels which permits holding and manipulation a steering wheel without actually grasping it with the hands.

Anson, p. 1, Right Column, Lines 1-5.

The examiner also seeks to equate Anson's use of the term "deflection" as synonymous with "deformable." This is not supported by Anson. Anson's use of the term "deflection" is according to the following:

In practice, it is found that an auxiliary grip attachment constructed of a rubber composition, which has a hand grip portion in the form of a hollow bulb, shaped to fit the hand, is particularly adapted to comfortable and non-fatiguing gripping by the hand of the driver. The hand grip portion is provided with a shank or neck of the same or similar composition material, which is in turn attached to the wheel by a suitable wheel gripping clamp. The neck portion is constructed of a sufficient thickness of the composition stock to provide sufficient rigidity therein to enable effective control of the wheel by suitable operating movements of the hand grip portion, while at the same time, the neck is sufficiently pliable so that it may be deflected from injurious contact with the body of the driver in the event of sudden stops or collisions which would tend to thrust the body of the diver against the attachment.

Anson, p. 1, Right Column, Lines 5-24.

It will also be evident that the pliability of the attachment greatly reduces the danger of injury to the driver from sudden stops or collisions which might tend to impel the body of the driver toward the wheel or attachment.

Anson, p. 2, Right Column, Lines 56-61.

As is shown by the quotations immediately above, “deflection” that is contemplated in the Anson is not “deformation” as set forth in the appealed claims. The deflection of Anson is meant to reduce the risk of injury caused by the hand grip in the lap area not movement from the supporting position as in the claims on appeal. More specifically, this is not deformation of the second section out of interference as claimed in the appealed claims so the driver can grab the wheel as shown in Figures 3 and 4 of the application on appeal.

Moreover, the operable position of the Anson hand grip is in the pendent position so that it will achieve the desired results. To the extent it may be moved so that it is not used, it is placed at a location where it will not be contacted. The Examiner has not disputed this position of Appellant, in fact, the Examiner cites this portion Anson in the Examiner’s Answer. See Examiner’s Answer, p. 13. At this location, Anson explicitly states the hand grip is not in use. As such, there is no teaching that it would be in use and then deformable out of interference as claimed in the appealed claims.

Noting the foregoing, Appellant has shown that the appealed claims are not anticipated by Anson. Therefore, the Board should reverse the Examiner’s rejection based on Anson and remand it to the Examiner with instructions to withdraw the anticipation rejection based on Anson.

VI. Conclusion

Appellant has demonstrated that the dictionary definition provided during prosecution were properly included as part of the record, the Examiner's reliance on case law is misplaced if such case law is reviewed for its facts and holdings, and the Examiner has failed to make out a *prima facie* case for anticipation based on Van Arsdel, Anson, or Laubach. Given this, it is prayed that the Board will reverse the indefiniteness rejection and the anticipation rejections, and remand the application to the Examiner with instructions to allow the appealed claims and pass the application to issue.

No fees are believed due; however, please charge any additional fees due or overpayments to Deposit Account No. 08-0219.

Respectfully submitted,

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